

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte LYNN E. SPITLER and ANTHONY E. MAIDA III

Appeal No. 1998-3009  
Application No. 08/105,444

ON BRIEF

MAILED

JAN 31 2001

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before WINTERS, WILLIAM F. SMITH and ADAMS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

Remand to the Examiner

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

The examiner issued an Examiner's Answer on April 30, 1996 (Paper No. 20). Therein, the examiner withdrew a pending rejection of the claims under 35 U.S.C. § 103 and maintained a rejection of the claims under 35 U.S.C. § 112, first paragraph (enablement). In maintaining the enablement rejection, the examiner relied upon documents made of record for the first time in the Answer.

See, page 8 of the Examiner's Answer. As a result, the examiner set a time period of two months from the mailing date of the Answer for appellants to respond to "any new ground of rejection." See, page 16 of the Examiner's Answer. Appellants filed a Reply Brief on July 5, 1996, responding to the new ground of rejection. The Reply Brief is accompanied by eight references. However, review of the Reply Brief does not easily reveal why the eight references are included. The examiner issued a communication on February 19, 1998, acknowledging receipt of the Reply Brief stating that the Reply Brief had been entered and considered but no further response was deemed necessary. This was error on the examiner's part.

As set forth in the then existing provisions of the MPEP § 1208.04 (Manual of Patent Examining Procedure, 6<sup>th</sup> ed. January 1995), "If the reply brief was filed in response to a new ground of rejection in the examiner's answer, the examiner must issue a supplemental answer indicating whether the new ground of rejection has been overcome, and, if it has not, explaining why not." Clearly, the examiner was under the obligation to issue a substantive response to the Reply Brief. In the examiner had done so, we believe the examiner would have questioned the presence of the eight documents which accompanied with the Reply Brief to clarify the purpose for which they were submitted. However, this error on the examiner's part was quickly overtaken by subsequent events.

A PTO form-413 "Interview Summary" was entered in the file as Paper No. 23. It makes of record a personal interview held between the examiner, co-appellant Spitler and apparently appellants' representatives held on April 29,

1998. In relevant part the form indicates that the examiner will "reconsider" certain issues. Appellants followed the interview by filing a paper entitled "Submission of Additional Data" (Paper No. 24) which is accompanied by five declarations. Therein appellants indicate that during the personal interview, a continuation-in-part application 08/288,057 was discussed. Appellants represent at page 1 of the paper that "[d]uring the interview, the possibility of introducing declaratory evidence into the present case which was provided to the Office in the '057 case was discussed. The Examiner kindly agreed to make of record this evidence in the present case."

The examiner issued a second communication on August 20, 1998 (Paper No. 25) stating "[t]he Submission of Additional Data, filed 5/26/98 .... has been entered and considered but no further response by the Examiner is deemed necessary." The examiner then forwarded the file to the Board.

It is not clear from the record what the examiner would have this merits panel do in regard to the Reply Brief and eight documents attached thereto and the five declarations submitted by appellants on May 7, 1998, all of which have been entered into the record by the examiner. By statute, this Board serves as a board of review, not a de novo examination tribunal. 35 U.S.C. § 6(b). The examiner has allowed new evidence into the record subsequent to the Notice of Appeal yet has not substantively treated the new evidence. As the record now stands, neither appellants nor this merits panel have any understanding why the examiner did not find the evidence persuasive. When an examiner allows new evidence into the record after the Notice of Appeal has been filed, he or she

undertakes the responsibility to properly consider the evidence and complete the record as to his or her position why the evidence is not persuasive. Absent a thorough, fact-based analysis as to the perceived shortcomings of the new evidence introduced belatedly in the appeal, we have no basis upon which to reasonably review the examiner's decision that the claims are unpatentable.

Upon return of the application, the examiner should take a step back and review the merits of the rejection in light of all the evidence now of record. If the examiner remains of the opinion that the claims on appeal are unpatentable under 35 U.S.C. § 112, first paragraph (enablement) or any other section of the statute, he should issue an appropriate Office action setting forth the facts and reasoning used in support of such a rejection. In this regard, we state that we are NOT authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1) (1997). Any further communication by the examiner which sets forth a rejection of the claims should provide appellants with a full and fair opportunity to respond.

If the examiner believes that the claims on appeal are in violation of the enablement requirement of 35 U.S.C. § 112, first paragraph, we refer the examiner to the opinion in Enzo Biochem. Inc. v. Calgene, Inc., 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999), as it provides a model for a fact-based evaluation, application and explanation of the so-called Forman factors.

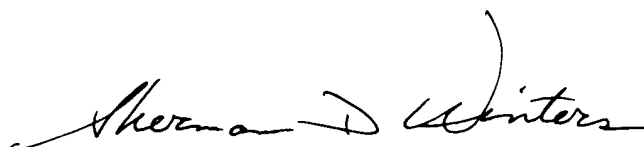
As a separate matter, we note that continuation-in-part application 08/288,057, referenced in the Submission of Additional Data, has now issued as U.S. Patent No. 5,925,362. The examiner should review the claims of the issued

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patent and determine whether an obviousness-type double patenting rejection is proper in this application.

This application, by virtue of its "special" status, requires an immediate action MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

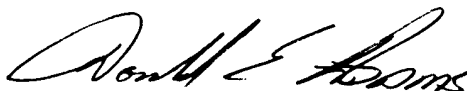
REMANDED



SHERMAN D. WINTERS  
Administrative Patent Judge



WILLIAM F. SMITH  
Administrative Patent Judge



DONALD E. ADAMS  
Administrative Patent Judge

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